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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,926	09/11/2003	Mazen Chmaytelli	990545	8382

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QUALCOMM INCORPORATED
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EXAMINER

HALIYUR, VENKATESH N

ART UNIT	PAPER NUMBER
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2419

NOTIFICATION DATE	DELIVERY MODE
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09/25/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/661,926

Applicant(s)

CHMAYTELLI ET AL.

Examiner

VENKATESH HALIYUR

Art Unit

2419

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/26/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31(claim 20 canceled) is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19,21--31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on 05/26/2009 has been considered but is ineffective to overcome the references. Rejection follows.
2. Claims 1-31 are pending in the application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 21-29 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter.

Regarding claims 21-29, these claims are directed to "A computer-readable storage medium containing instructions, which when executed by a computer..." fails to meet 101 guidelines set forth therein. Claim 21 is non-statutory because a "medium" cannot comprise or contain instructions and as a result the medium is just instructions and therefore fails to fall within a statutory category. In order for a computer-readable medium comprising instructions to be statutory it must be embodied (encoded) in a computer readable medium with the

instructions capable of being executed by a computer (please refer to pages 52-54 of the 101 guidelines for further details). Claims 22-29 are also rejected since they depend from claim 21 and contains the same deficiency. Therefore the claimed application in claims 21-29 is nothing but instructions or software and therefore is non-statutory.

It is well established as evidenced above that a computer-readable medium comprising instructions or a computer program, per se is not a physical "thing". Also in para 0028 of the specification, the instructions is defined to be residing in various types of signal-bearing media.

Thus, claims 21-29 are non-statutory since the patent protection sought by the claimed invention is for the computer program in the abstract and for a signal claim.

Therefore these claims must be canceled or the line "The instructions can reside in various types of signal-bearing or data storage primary, secondary, or tertiary media" in para 28 of the specification must be removed since instructions are defined to reside in various types of signal-bearing media.

Also it is suggested that instead of "A computer-readable storage medium containing instructions, which, when executed..." is recited to read as "A computer-readable storage medium encoded with computer executable instructions..., which, when executed..."

Appropriate corrections are required to these claims.

Claim Rejections - 35 USC § 112

5. Claims 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 21 claims “computer-readable storage medium containing instructions...” is indefinite because it is unclear how a medium can contain instructions. A medium can have instructions stored on it, recorded on it, but it is not clear how it can just contain instructions. Claims 22-29 are also rejected since they depend from claims 26 and contain the same deficiency. Appropriate corrections are required to these claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-19, 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. [US Pub: 2003/0112952] and Payne et al. [7,003,327] further in view of Mohan et al. [US Pub: 2003/0063590].

Regarding claim 1, Brown et al in the invention of “Automatically Establishing a Telephone Connection Between a Subscriber and a Party Meeting One or More Criteria” disclosed a wireless device (**items 502, 504, Figs 5/6, para 0152-0153, 0168-169**) comprising: having a processor (**item 530 of Fig 5**); a wireless communication interface (**item 528 of Fig 5**), coupled to said processor, wherein the wireless communication interface selectively receives (**filter or screen calls, para 0094**) an attempted incoming communication connection across a wireless network, and a memory (**para 0018**), coupled to said processor (**para 0045-0047**), wherein the processor is operable to (**para 0033-0037, Fig 1**): classify (**item 524 of Fig 5, para 0091**) the attempted incoming communication connection using identifying information of the attempted incoming (**caller identification**) communication connection (**para 0090**); and perform a predetermined response to the attempted incoming communication connection based upon a classification of the attempted incoming communication connection (**classify the attempted calls according to calling party classification, para 0091-0094**). Brown et al, disclosed that PDA, wireless telephone (**wireless device**) may comprise call processor (**item 120b of Fig 1, para 0047**) and the classification process in the wireless device (**0057-0063**) but Brown et al fails to explicitly disclose that the processor is located at a wireless device. However, Payne et al in the invention of “Heuristically Assisted User Interface for a Wireless Communication Device” disclosed a mobile device (**item 300 of Fig 3**) including the wireless communication interface coupled to a

processor (**item 304 of Fig 3**), and the memory (**item 324 of Fig 3**) coupled to the processor module for performing processing tasks (**col 9, lines 38-67, col 10, lines 1-29**) to provide predetermined responses based on the incoming service request (**col 10, lines 30-67, col 11, lines 1-57, Fig 4**) (**col 5, lines 53-67, and col 6, lines 1-11**). Therefore it would have been obvious for one of the ordinary skill in the art at the time the invention was made to use the method of including a processor coupled to the memory and the client module for performing processing tasks in the wireless device as taught by Payne et al in the system of Brown et al to include a processor coupled to a memory and a classifier in the wireless device to classify the incoming communication connection.

Both Brown and Payne fails to positively disclose the limitation of call handling ability at a wireless device to perform predetermined response to the attempted incoming communication based up on a classification of the attempted incoming communication, however Mohan et al disclosed a method at a wireless device (**item 102 B of Fig 5**) to generate a predetermined response to an attempted incoming call based on a classification of the attempted incoming communication (**Figs 6-9, para 0080-0085, 0093**).

Therefore it would have been obvious for one of the ordinary skill in the art at the time the invention was made to use the method of including a processor coupled to the memory and the client module for performing processing tasks in the wireless device as taught by Mohan et al in the system of Brown et al as

modified by Payne et al to generate a predetermined response to an attempted incoming call based on a classification of the attempted incoming communication **(Figs 5-7, para 0093)**. One is motivated as such in order to provide a predetermined response to improve the call handling ability based on the classification and identification of the incoming call at a wireless device **(Payne et al, col 13, lines 22-33)**.

Regarding claims 2-3,12-13,22-23, Brown et al disclosed that the predetermined response is to block **(filter or screen calls)** the attempted incoming communication connection attempt and the predetermined response includes an audio response **(voice message/mail)** to the attempted incoming communication connection **(para 0094)**.

Regarding claim 4, 14, 24, Brown et al disclosed that the predetermined response is to request user input as to whether to accept the attempted incoming communication connection **(para 0032-0033, 0039-0042)**.

Regarding claim 5, 15, 25, Brown et al disclosed that the predetermined response is to return a data response to the attempted incoming communication connection **(para 0124)**.

Regarding claim 6, 16, 26, Brown et al disclosed that the classification of the attempted incoming communication connection occurs from identifying the telephone number of a calling telephone making the attempted incoming communication connection to the device **(para 0037)**.

Regarding claims 7-8, 17-18, 27-28, Brown et al disclosed that the classification occurs through the receipt of Caller ID for the attempted incoming communication connection and the classification occurs through the receipt of identity data within the attempted incoming communication connection (**para 0091-0093**).

Regarding claim 9, 19, 29, Brown et al disclosed that the predetermined response is to send a short messaging service (**SMS**) message to the device making the attempted incoming communication connection (**para 0124**).

Regarding claim 10, Brown et al disclosed a computer wireless device (**items 502, 504, Fig 5, para 0152**), comprising: means for selectively receiving (**filter or screen calls**) an attempted incoming communication connection across a wireless network (**Fig 1**); means for classifying (**item 524 of Fig 5**) the attempted incoming communication connection using identifying information of the attempted incoming communication connection (**para 0090, 0168**); and means for performing a predetermined response to the attempted incoming communication connection based upon a classification of the attempted incoming communication connection (**classify the attempted calls according to calling party classification, para 0091-0094, 0170**). Brown et al, disclosed that PDA, wireless telephone (wireless device) may comprise call processor (**item 120b of Fig 1, para 0047**) and the classification process in the wireless device (**0057-0063**) but Brown et al fails to explicitly disclose that the processor is located at a wireless device. However, Payne et al disclosed a mobile device (**item 300 of**

Fig 3) including the wireless communication interface coupled to a processor **(item 304 of Fig 3)**, and the memory **(item 324 of Fig 3)** coupled to the processor module for performing processing tasks **(col 9, lines 38-67, col 10, lines 1-29)** to provide predetermined responses based on the incoming service request **(col 10, lines 30-67, col 11, lines 1-57, Fig 4) (col 5, lines 53-67, and col 6, lines 1-11)**. Therefore it would have been obvious for one of the ordinary skill in the art at the time the invention was made to use the method of including a processor coupled to the memory and the client module for performing processing tasks in the wireless device as taught by Payne et al in the system of Brown et al to include a processor coupled to a memory and a classifier in the wireless device to classify the incoming communication connection.

Both Brown and Payne fails to positively disclose the limitation of call handling ability at a wireless device to perform predetermined response to the attempted incoming communication based up on a classification of the attempted incoming communication, however Mohan et al disclosed a method at a wireless device **(item 102 B of Fig 5)** to generate a predetermined response to an attempted incoming call based on a classification of the attempted incoming communication **(Figs 6-9, para 0080-0085, 0093)**.

Therefore it would have been obvious for one of the ordinary skill in the art at the time the invention was made to use the method of including a processor coupled to the memory and the client module for performing processing tasks in the wireless device as taught by Mohan et al in the system of Brown et al as

modified by Payne et al to generate a predetermined response to an attempted incoming call based on a classification of the attempted incoming communication **(Figs 5-7, para 0093)**. One is motivated as such in order to provide a predetermined response to improve the call handling ability based on the classification and identification of the incoming call at a wireless device **(Payne et al, col 13, lines 22-33)**.

Regarding claims 11, Brown et al disclosed a method for responding to incoming communication connection attempts at a wireless device **(items 502, 504, para 0152)** the method comprising **(para 0017-0018)**: receiving an attempted incoming communication connection at a wireless device, storing the incoming communication in a memory of the wireless device **(para 0047,0152-0153)**; classifying the attempted incoming communication connection using identifying information **(caller identification)** of the attempted incoming communication connection **(para 0090)**; and performing a predetermined response to the attempted incoming communication connection based upon a classification of the attempted incoming communication connection **(classify the attempted calls according to calling party classification, para 0091-0094, 0154, Fig 1)**. Brown et al, disclosed that PDA, wireless telephone (wireless device) may comprise call processor **(item 120b of Fig 1, para 0047)** and the classification process in the wireless device **(0057-0063)** but Brown et al fails to explicitly disclose that the processor is located at a wireless device. However, Payne et al disclosed a mobile device **(item 300 of Fig 3)** including the wireless

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communication interface coupled to a processor (**item 304 of Fig 3**), and the memory (**item 324 of Fig 3**) coupled to the processor module for performing processing tasks (**col 9, lines 38-67, col 10, lines 1-29**) to provide predetermined responses based on the incoming service request (**col 10, lines 30-67, col 11, lines 1-57, Fig 4**) (**col 5, lines 53-67, and col 6, lines 1-11**).

Therefore it would have been obvious for one of the ordinary skill in the art at the time the invention was made to use the method of including a processor coupled to the memory and the client module for performing processing tasks in the wireless device as taught by Payne et al in the system of Brown et al to include a processor coupled to a memory and a classifier in the wireless device to classify the incoming communication connection.

Both Brown and Payne fails to positively disclose the limitation of call handling ability at a wireless device to perform predetermined response to the attempted incoming communication based up on a classification of the attempted incoming communication, however Mohan et al disclosed a method at a wireless device (**item 102 B of Fig 5**) to generate a predetermined response to an attempted incoming call based on a classification of the attempted incoming communication (**Figs 6-9, para 0080-0085, 0093**).

Therefore it would have been obvious for one of the ordinary skill in the art at the time the invention was made to use the method of including a processor coupled to the memory and the client module for performing processing tasks in the wireless device as taught by Mohan et al in the system of Brown et al as

modified by Payne et al to generate a predetermined response to an attempted incoming call based on a classification of the attempted incoming communication **(Figs 5-7, para 0093)**. One is motivated as such in order to provide a predetermined response to improve the call handling ability based on the classification and identification of the incoming call at a wireless device **(Payne et al, col 13, lines 22-33)**.

Regarding claim 21, Brown et al disclosed a computer-readable medium comprising instructions, which when executed by a computer in a wireless device **(items 502, 504 of Fig 5, para 0152)** causes the computer to perform operations, the instructions comprising **(para 0017-0018)**: at least one instruction for receiving an attempted incoming communication connection from another device across a wireless network **(Fig 1)**; at least one instruction for classifying the attempted incoming communication connection using identifying information **(caller identification)** of the attempted incoming communication connection **(para 0090)**; and at least one instruction for performing a predetermined response to the attempted incoming communication connection based upon a classification of the attempted incoming communication connection **(classify the attempted calls according to calling party classification, para 0091-0094)**.

Brown et al, disclosed that PDA, wireless telephone (wireless device) may comprise call processor **(item 120b of Fig 1, para 0047)** and the classification process in the wireless device **(0057-0063)** but Brown et al fails to explicitly disclose that the processor is located at a wireless device. However, Payne et al

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disclosed a mobile device (**item 300 of Fig 3**) including the wireless communication interface coupled to a processor (**item 304 of Fig 3**), and the memory (**item 324 of Fig 3**), coupled to the processor module for performing processing tasks (**col 9, lines 38-67, col 10, lines 1-29**) to provide predetermined responses based on the incoming service request (**col 10, lines 30-67, col 11, lines 1-57, Fig 4, col 5, lines 53-67, and col 6, lines 1-11**).

Therefore it would have been obvious for one of the ordinary skill in the art at the time the invention was made to use the method of including a processor coupled to the memory and the client module for performing processing tasks in the wireless device as taught by Payne et al in the system of Brown et al to include a processor coupled to a memory and a classifier in the wireless device to classify the incoming communication connection.

Both Brown and Payne fails to positively disclose the limitation of call handling ability at a wireless device to perform predetermined response to the attempted incoming communication based up on a classification of the attempted incoming communication, however Mohan et al disclosed a method at a wireless device (**item 102 B of Fig 5**) to generate a predetermined response to an attempted incoming call based on a classification of the attempted incoming communication (**Figs 6-9, para 0080-0085, 0093**).

Therefore it would have been obvious for one of the ordinary skill in the art at the time the invention was made to use the method of including a processor coupled to the memory and the client module for performing processing tasks in

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the wireless device as taught by Mohan et al in the system of Brown et al as modified by Payne et al to generate a predetermined response to an attempted incoming call based on a classification of the attempted incoming communication **(Figs 5-7, para 0093)**. One is motivated as such in order to provide a predetermined response to improve the call handling ability based on the classification and identification of the incoming call at a wireless device **(Payne et al, col 13, lines 22-33)**.

Regarding claims 30-31, Brown et al disclosed wherein the process is further operable to: provide a default response to a calling party that is attempting the attempted incoming communication connection, if the processor cannot classify the attempted incoming communication connection, the default response not being an establishment of a connection between the calling party and the wireless device wherein the default response is an audio message configured for unidentified calling parties **(default to voice mail system, para 0094)**.

Response to Arguments

8. Applicant's argument, see remarks filed on 05/26/2009 with respect to claims 1-31 have been fully considered.

With respect to applicant's argument that Brown nor Payne has any call handling ability at the wireless device to perform predetermined response. However the examiner respectfully disagrees as Payne disclosed a Mobile device (item 300 of Fig 3 with

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functionality to establish communication session with a gateway and perform call processing tasks in the mobile device (col 10, lines 1-20). However, both Brown and Payne fails to positively disclose the limitation of call handling ability at a wireless device to perform predetermined response to the attempted incoming communication based up on a classification of the attempted incoming communication connection and the examiner used Mohan reference to over come this deficiency. Mohan disclosed a call flow sequence for wireless handsets with predetermined responses (default responses) between the called and calling parties in Figs 6-9, para 0080-0085 and therefore obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Conclusion

9. THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications should be directed to the attention to Venkatesh Haliyur whose phone number is 571-272-8616. The examiner can normally be reached on Monday-Friday from 9:00AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached @ (571)-272-7884. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (571)-272-2600 or fax to 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197(toll-free).

/Venkatesh Haliyur/

Examiner, Art Unit 2419

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/Ayaz R. Sheikh/

Supervisory Patent Examiner, Art Unit 2419